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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.        |
|---|-------------|----------------------|---------------------|-------------------------|
| 10/055,189  | 01/25/2002  | Sarah E. Campbell    | D/A1496 (1508/3550) | 9199                    |
| 7590  | 11/01/2006  |                      |                     | EXAMINER<br>QIN, YIXING |
| Gunnar G. Leinberg, Esq.<br>Nixon Peabody LLP<br>Clinton Square<br>P.O. Box 31051<br>Rochester, NY 14603-1051 |             |                      | ART UNIT<br>2625    | PAPER NUMBER            |
| DATE MAILED: 11/01/2006   |             |                      |                     |                         |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                 |
|------------------------------|-----------------|-----------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)    |
|                              | 10/055,189      | CAMPBELL ET AL. |
|                              | Examiner        | Art Unit        |
|                              | Yixing Qin      | 2625            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-39 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

In response to applicant's amendment received 8/11/06, all requested changes have been entered.

### ***Response to Arguments***

Applicant's arguments filed 8/11/06 have been fully considered but they are not persuasive. Regarding independent claims 1, 11 and 21, and also claims, 5, 15 and 25, the Shibata reference does disclose a communications network for relaying supplier information (i.e. data bus 19). There is a LAN network 12 for communication as well. The point here is that even though a supplier has been pre-designated, the contacting of a supplier for supplying consumables is still an act of identification. Note that in P[0055] the email analyzer can analyze emails received from the service depot 16, which inherently acts as an identification of the service depot 16.

Regarding claims 4, 14, and 24, the Shibata reference discloses in P[0047] and P[0048] various information that is registered. Note that in P[0047] the registration unit 3 registers a TTI of the facsimile device and location information of a manager's PC 13 and of the service depot 16. Also in P[0057], the Email that is sent out to for ordering a consumable replacement includes such information as the terminal information, order contents and the service depot info. Thus, although Shibata does not explicitly disclose that the service depot is identified based upon a location of the facsimile, it would be obvious to choose a service depot based upon proximity to the service depot.

Regarding claims 6, 16 and 26, the use of the Suyehira and Office Depot website prices was to show that the prices of consumables is a known type of relevant information that can be accessed using a browser. However, upon further review, a new reference, Parry et al (U.S. Patent No. 7,031,013) teaches/suggests the identification of prices of consumables from a vendor. Please see the rejection below for more detail.

The objection of claims 31-33 in the previous office action has been withdrawn since the Examiner agrees with the arguments made.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

I. Claims 1-3, 7-9, 11-13, 17-19, 21-23, 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibata (U.S. Pub. No. 2002/0008883).

Regarding claims 1, 11, 21, Shibata discloses a method comprising:

requesting, with a peripheral device via a communications network connected to the peripheral device (LAN 12), an identity of at least one supplier for at least one consumable for the peripheral device (P[0063] - the facsimile determines if the necessary information (which is shown in Fig. 3) for a sending a toner ordering request. Fig. 3 shows service depot (i.e. supplier) information)

receiving, at the peripheral device via the communications network information identifying the at least one supplier for the at least one consumable based on the request (Lines 5-10 of P[0063]. See P[0055], where an email analyzer analyzes an incoming email from the service depot 16)); and

indicating with the peripheral device, the identified at least one supplier. (P[0064]  
the generated email 6A indicates the email address of the identified supplier. )

Regarding claims 2, 12, 22, Shibata discloses indicating, at the peripheral device, when replacement of at least one of the consumables in the peripheral device is recommended, wherein the request is based on the indication of the recommended replacement. (Fig. 4, S2, S3 and S4 and P[0062, 0063 and 0064])

Regarding claims 3, 13, 23 Shibata discloses retrieving information about the peripheral device making the request, wherein the identifying the at least one supplier is based on the retrieved information. (P[0063], line 3, terminal information is needed in order to create an email requesting a refill toner.)

Regarding claims 7, 17, 27 Shibata discloses wherein the received information further comprises information identifying a location of the identified at least one supplier, and the indicating further comprises indicating the location of the identified at least one supplier. (Fig. 3 and 7A shows the electronic location of a supplier by identifying its email and fax number.)

Regarding claims 8, 18, 28 Shibata discloses submitting, with the peripheral device, an order for the at least one consumable to the at least one identified supplier. (S4 of Fig. 4)

Regarding claims 9, 19, 29 Shibata discloses processing the submitted order (P[0067-0068]); and supplying the at least one consumable for the peripheral device. (P[0070])

Regarding claims 31, 32, 33 Shibata discloses receiving the request; (P[0058]) and identifying the at least one supplier for the at least one consumable based upon the request (P[0055])

Regarding claims 34, 35, 36 Shibata discloses said indicating the identified at least one supplier comprises at least one of displaying received identification

information and printing received identification information. (Figs. 3, 6A and 7A show various ways to identify and display the service depot 16.)

Regarding claims 37, 38, 39 Shibata discloses the peripheral device is a device selected from a printer, copy machine, and a facsimile machine. (P[0034] shows his invention is an Internet fax machine.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 14, 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (U.S. Pub. No. 2002/0008883).

Regarding claims 4, 14, 24, Shibata discloses in P[0047] and Fig. 3 a TTI (transmitter terminal information).

It does not explicitly disclose "wherein the retrieved information about the peripheral device identifies a location of the peripheral device and the identifying of the at least one supplier is based on the identified location of the peripheral device."

However, in P[0047] the registration unit 3 registers a TTI of the facsimile device and location information of a manager's PC 13 and of the service depot 16. Also in

P[0057], the Email that is sent out to for ordering a consumable replacement includes such information as the terminal information, order contents and the service depot info. Thus, although Shibata does not explicitly disclose that the service depot is identified based upon a location of the facsimile, it would be obvious to choose a service depot based upon proximity to the service depot.

Therefore, it would have been obvious for one of ordinary skill to use an analogous method of identifying a peripheral device (such as using the location of the device).

The motivation of using the TTI is to identify the facsimile so that the correct toner can be ordered.

Therefore, it would have been obvious to use Shibata to obtain the invention as specified.

Claim 5, 15, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable Shibata (U.S. Pub. No. 2002/0008883) in view of Suyehira (U.S. Patent No. 6,947,161)

Regarding claims 5, 15, 25, Shibata discloses in Fig. 7A an e-mail indicating that toner is available and will be delivered soon.

It does not explicitly disclose “wherein the received information further comprises information identifying a quantity of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the identified quantity of the at least one consumable.”

However, The secondary reference, Suyehira, discloses in column 6, line 55-58, that if the orderer in the Suyehira printer orders a component that is no longer available (i.e. the quantity is 0), the order tracker keeps track of this information.

Both references are in the art of ordering consumables for a printing device when the amount of the consumable is low.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included combined the Shibata and Suyehira inventions to allow the combined invention to be able to identify, at least, that an ordered consumable is no longer available for delivery.

The motivation would be to allow an user to know if the user needs to look elsewhere for the consumable or to upgrade an existing printing machine because it might be going out of date.

Therefore, it would have been obvious to combine Shibata and Suyehira to obtain the invention as specified.

Claims 6, 16, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable Shibata (U.S. Pub. No. 2002/0008883) in view of Suyehira (U.S. Patent No. 6,947,161) in view of Parry et al (U.S. Patent No. 7,031,013).

Claims 6, 16, 26

The method as set forth in claim 1:

Shibata discloses the invention as cited in claims 1 (11, 21). Neither Shibata nor Suyehira discloses “wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier and the indicating the identified at least one supplier further comprises indicating each identified price of the at least one consumable. “

The tertiary reference, Parry et al discloses in column 1, lines 45-55 that their invention is for the monitoring of consumables and prices for the consumables.

All references are in the art of printing using consumables.

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to create a device capable of obtaining price information of a consumable.

The motivation would be to allow a user to know how much the consumable is going to cost.

Therefore, it would have been obvious to combine all three inventions.

Claims 10, 20, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable Shibata (U.S. Pub. No. 2002/0008883) in view of Borg et al (U.S. Patent No. 6,982,802 – “Borg”).

Regarding claims 10, 20, 30, Shibata discloses the invention as cited in claims 9, (19, and 29).

Shibata does not explicitly disclose the paying for the order of a consumable.

However, the secondary reference, Borg, discloses in column 5, lines 47-67 and column 6, lines 1-4 the purchasing of a consumable and deciding if purchase discounts are available.

Both references are in the art of ordering consumables for a printing device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the inventions from Shibata and Borg to have included payment processing as part of the ordering process.

The motivation would be to let a user know how much money a particular toner cartridge costs.

Therefore, it would have been obvious to combine the two references.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



YQ



**TWYLER LAMB**  
**SUPERVISORY PATENT EXAMINER**